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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ALPERT, JAMES M

ART UNIT PAPER NUMBER

3624

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/776,503

Applicant(s)

BLACKSON ET AL.

Examiner

James Alpert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/17/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-86 is/are rejected.
- 7) ☒ Claim(s) 3,8 and 55-82 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |


DETAILED ACTION

The following communication is in response to Applicant's appeal brief that was filed March 17, 2006. In view of said brief, PROSECUTION IS HEREBY REOPENED. New grounds of rejections and objections (along with responses to some arguments) are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing adjacent:  (VINCENT MILLIN)

Response to Certain Arguments in the Appeal Brief

With regard to the rejections under Ex Parte Lyell, Applicants' arguments are persuasive, and these rejections under 35 U.S.C 112 and 101 are withdrawn.

With regard to the rejections under 35 U.S.C. 102(e), Applicants' arguments have been fully considered but are not persuasive as discussed below.

Claim Objections (Improperly Dependent)

MPEP §608.01(n) states as follows:

The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim.

A dependent claim does not lack compliance with 35 U.S.C. 112, fourth paragraph, simply because there is a question as to (1) the significance of the further limitation added by the dependent claim, or (2) whether the further limitation in fact changes the scope of the dependent claim from that of the claim from which it depends. The test for a proper dependent claim under the fourth paragraph of 35 U.S.C. 112 is whether the dependent claim includes every limitation of the claim from which it depends. The test is not one of whether the claims differ in scope.

Claims 55-82 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to pass the infringement test. Specifically, one could infringe on the method steps of Claims 55-81 but yet not be infringing on the particular apparatus as claimed in Claim 7. Further, Claim 82 is rejected because one could infringe on this claim by developing a media to implement step (c) of Claim 55, but not infringe on the entirety of Claim 55. Applicant is required to cancel the claims or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form.

Claim Objections (Rejected Base Claim)

Claims 3,8,58 are specifically objected to being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The examiner has provided specific suggestions below regarding this objection. Claim 58 is objected presuming the correction of Claim 55 as to being improperly dependent.

Claim Rejections - 35 USC § 102

The text of 35 U.S.C. §102(e), which is not included in this action, can be found in a prior Office action. Claims 1-2,83 are rejected under 35 U.S.C. 102(e) as being anticipated by De Leo, U.S. Patent #6381626.

Applicants' primary argument, in the Examiner's opinion, is that DeLeo does not disclose an apparatus wherein there are two input devices, and cash is dispensed responsive to a first user input, and where digital information files are dispensed in response to a user input that corresponds to a digital information file.

Because of the relative breadth of Claim 1, the Examiner must respectfully disagree that DeLeo is inapplicable. Applicant has put forward many questions in the Appeal brief, and the examiner will try to answer at least some of them (along with additional explanation).

Q: Where does DeLeo teach a second user input?

A: Where do Applicants claim a second user input in Claim 1. Applicant merely claims "at least one user input". An ATM machine with only one user input would satisfy this claim because one (1) is, in fact, at least one (1). Even so, DeLeo teaches both an input for accepting a user's card as well as an input for accepting a user's PIN numbers, thus disclosing more than one user input. See (DeLeo, Col. 7, lines 5-22).

Q: Where does De Leo teach that a non-transaction message is displayed in response to a digital information file dispense (second) user input instead of a cash dispense transaction (first) user input? Also, exactly where does De Leo provide a

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(second) input (different than the transaction data first input) that causes a digital information file to be dispensed?

A: Applicants argue that the digital files dispensed to the user in the form of a video advertisement are responsive to the host/terminal system. The examiner would refer Applicants to (DeLeo, Column 5, lines 45-60). This passage discloses that the code responsible for deciding which file is dispensed to a user can be based on various information supplied by the user, including whether the user's card is from an account at a different bank, or a bank in a foreign country, or other related information, such as choice of language or transaction amount.

Further, a careful reading of Applicants' Claim 1 reveals that the claim does not expressly require that a second user input differ from a first user input. Even so, in a reasonable interpretation of DeLeo, it can be observed that DeLeo dispenses cash in response to a user's input of a PIN and/or transaction amount, while a digital file is dispensed corresponding to information input by the user that is found on the card or in selection of language or transaction amount. Thus currency and files are dispensed corresponding to two different user inputs.

The examiner would also observe that there are no explicit temporal requirements in Applicants' Claim 1. The fact that DeLeo dispenses a digital file while/during/after dispensing cash seems irrelevant, as long as the dispensing is in response to user inputs. Finally, the 10th edition of Merriam Webster's Collegiate Dictionary defines dispense as "to distribute" and also "to deal out in portions", and lists a synonym as

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"DISTRIBUTE". The examiner concludes that the delivery of the digital file through an output device in DeLeo is in accord with these definitions.

Thus with regard to Claim 1, DeLeo teaches an apparatus comprising:

at least one computer processor;
(Col. 4, lines 52-67)

at least one data store in operative connection with the computer processor, wherein
(Col. 4, lines 52-67)

the computer processor is operative to cause a plurality of digital information files to be retrieved from at least one digital information source located remotely from the machine and saved in the data store; (Col. 4, lines 8-32)

at least one input device in operative connection with the computer processor;
(Figure 3, items 60,64,66)

a cash dispenser device in operative connection with the computer processor,
(Figure 3, items 60,70)

wherein the computer processor is operative to cause the cash dispenser to dispense currency responsive to at least one first input through the at least one input device;
(Col. 10, lines 30-34, and this is inherent to an ATM machine)

and at least one output device in operative connection with the computer processor,
(Col. 3, lines 32-56)

wherein the computer processor is operative to cause the dispense of at least one of the digital information files through the at least one output device
(Col. 3, lines 32-56)

responsive to at least one second input through the at least one input device
(Col. 7, lines 5-46, which discusses a card input and additional user information input;
Column 5, lines 45-60)

that corresponds to the at least one digital information file.
(Column 5, lines 45-60)

With regard to Claim 2, DeLeo teaches an apparatus comprising:

card reader device in operative connection with the computer processor, wherein the card reader device is operative to read account indicia from a card, and wherein the computer processor is operative to cause one or more fees to be charged to the account corresponding to the dispense of currency and the dispense of the at least one digital information file. (Col. 7, lines 23-36)

One example of how DeLeo describes this claim is the situation where there may be a usage fee at the ATM, perhaps for a user being a customer of a different bank. In this case, the processor is operative to assess a fee, and then further causes the currency along with the digital file to be dispensed.

With regard to Claim 83, DeLeo teaches the apparatus wherein:

the computer processor is operative to cause a charge of at least one fee associated with the dispense of at least one digital information file. (Col. 7, lines 23-36)

Claim Rejections - 35 USC § 103(a)

The text of 35 U.S.C. §102(e), which is not included in this action, can be found in a prior Office action. Claim 6 is rejected under 103(a) as being unpatentable over De Leo. Claims 3-5,7,13-35,45-57,61-77,81-82,84-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Leo in view of Martin, U.S. Patent #5930765. Claims 8-12,36-44,58-60,78-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Leo in view of Martin and further in view of Lotspiech, U.S. Patent #6748539.

With regard to Claims 3-5, the examiner has read Applicants' arguments, and believes that the claims, as they currently stand, are not patentable over DeLeo in view of Martin. Thus the rejections over the claims, as they currently read, are maintained in the manner laid out in the Office Action, mailed 10/19/2005.

In addition, **Claims 3 is objected to as being dependent upon a rejected base claim, but would be allowable if certain elements of the dependent claims were rewritten in independent form.** Specifically, the examiner concludes that if Claim 3 were rewritten to include the elements of Claim 1, and also to include elements of Claims 8, wherein an output device is operative to connect to a portable computing device, the claim would recite allowable subject matter. As to Claims 4-6, should the underlying claims on which these claims depend be amended, reconsideration would be given as to their allowability.

With regard to Claim 6, licensing fees are old and well known in the art, and as such, it would have been obvious to modify DeLeo to include licensing fees to pay copyright holders of the advertising files.

With regard to Claim 7, upon further consideration the examiner has observed that the specification does not refer to a “digital content delivery fee authorization” so the examiner may take the liberty of interpreting this claim broadly. The examiner concludes that this term could easily refer to simple digital content (print characters) that are output to the screen or printing mechanism. The fee assessed would be a fee for accessing the ATM services including the digital content output to the screen and/or printer mechanism. This could result in this Claim being rejected under 102 in a manner as described in the explanation under Claim 2. However, in view of the nature of the entire application, it appears that the phrase a “digital content delivery fee authorization” refers to a fee that is designed specifically to cause digital content to be delivered without any cash being dispensed in a similar manner. Thus the examiner maintains his

rejections in the manner laid out in the Office Action, mailed 10/19/2005 under 35 U.S.C 103(a) that the claim is unpatentable of DeLeo in view of Martin (and perhaps vice-versa).

With regard to Claim 8-12, the examiner has read Applicants' arguments, and believes that the claims, as they currently stand, are not patentable over DeLeo in view of Martin and further in view of Lotspiech. Thus the rejections over the claims, as they currently read, are maintained the manner laid out in the Office Action, mailed 10/19/2005.

In addition, Claims 8 is objected to as being dependent upon a rejected base claim, but would be allowable if certain elements of the dependent claims were rewritten in independent form. Specifically, the examiner concludes that if Claim 8 were rewritten to include the elements of Claim 7, and also to include certain elements of Claim 10-11, those resembling Claim 3, and reflecting that the digital content was a digital sound music file, the claim would recite allowable subject matter. As to Claims 9-12, should the underlying claims on which these claims depend be amended, reconsideration would be given as to their allowability.

As to Claim 13-35, the examiner has read Applicants' arguments, and believes that the claims, as they currently stand, are not patentable over DeLeo in view of Martin. Thus the rejections over the claims, as they currently read, are maintained in the manner laid out in the Office Action, mailed 10/19/2005. Should the underlying claims on which these claims depend be amended, reconsideration would be given as to their allowability.

As to Claim 36-44, the examiner has read Applicants' arguments, and believes that the claims, as they currently stand, are not patentable over DeLeo in view of Martin, and further in view of Lotspiech. Thus the rejections over the claims, as they currently read, are maintained. Should the underlying claims on which these claims depend be amended, reconsideration would be given as to their allowability.

As to Claims 45-54, the examiner has read Applicants' arguments, and believes that the claims, as they currently stand, are not patentable over DeLeo in view of Martin. Thus the rejections over the claims, as they currently read, are maintained in the manner laid out in the Office Action, mailed 10/19/2005. Should the underlying claims on which these claims depend be amended, reconsideration would be given as to their allowability.

With regard to Claim 55, this method recites steps to operate the apparatus of Claim 7. As with that previous claim, the examiner is no long certain that the steps of the claim recite limitations broad enough that a rejection could be brought under 35 U.S.C. 102(e). One input device could be a card reader itself, while the other input device could be a device for accepting PIN numbers. The digital content could be output simply dispensed to the screen or to the printer apparatus. But given that this claim refers specifically to the apparatus which describes "digital content delivery fee authorization", the examiner maintains his rejections under 35 U.S.C 103(a) that the claim is unpatentable of DeLeo in view of Martin (and perhaps vice-versa).

As to Claim 58, this claim is initially **objected to as being dependent upon a rejected base claim, but would be allowable if certain elements of the dependent**

claims were rewritten in independent form. Specifically, the examiner concludes that if Claim 58 were rewritten to include the elements of Claim 55, and also to include certain elements of Claim 60-64, and reflecting that the digital content comprised digital files including sound music files, sound files, music files, and/or document files, the claim would recite allowable subject matter.

As to Claims 56-81, the examiner maintains that these claims are maintained in the manner laid out in the Office Action, mailed 10/19/2005, and are both rejected under DeLeo in view of Martin, or DeLeo in view of Martin, and further in view of Lotspiech, when the claims include the portable computing device. Should the underlying claims on which these claims depend be amended, reconsideration would be given as to their allowability.

With regard to Claim 82, this claim is rejected as being unpatentable over DeLeo in view of Martin, as such a combination would possess the required media to carry out step (c) of claim 55.

With regard to Claims 83-86, the examiner has read Applicants' arguments, and believes that the claims, as they currently stand, are not patentable over DeLeo in view of Martin. Thus the rejections over the claims, as they currently read, are maintained in the manner laid out in the Office Action, mailed 10/19/2005, and as discussed herein. The examiner believes however that if certain limitations regarding a portable computing device, along with a more specific indicator of the type of digital files being dispensed were incorporated into the independent claims, there would be allowable subject matter.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Alpert whose telephone number is (571) 272-6738. The examiner can normally be reached on M-F 9:00-5:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James M. Alpert
May 19, 2006



HANI M. KAZIMI
PRIMARY EXAMINER